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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,319	11/19/2001	Kazuya Ozaki	F-11800	8441

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EXAMINER

PHAM, TUAN

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/988,319

Applicant(s)

OZAKI, KAZUYA

Examiner

TUAN A. PHAM

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6, 8-18 and 20-22.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 09/06/2006 have been fully considered but they are not persuasive.

In response to applicant's remark on page 4, Applicant argues that the examiner fails to address page 5, line 16-page 6, line 13 in the remark filed on 05/17/2006.

In response to applicant's arguments as stated above, the Examiner respectfully disagrees with the Applicant's argument. The applicant should refer back to the Final Office Action mailed on 07/06/2006, at pages 2-3 wherein the examiner has addressed all the issue has been argued by the applicant.

In response to applicant's remark, Applicant argues that the examiner has fails to combine Gray in view of Narayanaswamy in claims 1, 4, 6, 8-9, and 13, and applicant also alleges that there is no motivation to combine Gray in view of Narayanaswamy.

In response to applicant's arguments as stated above, the Examiner respectfully disagrees with the Applicant's argument. It appears applicant is attacking individual merits of Gray, and Narayanaswamy and concludes that there is no impetus to combine them. However, the 103 rejection is in consideration of Gray in view of Narayanaswamy as a whole. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a

rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Narayanaswamy as a secondary teaching is not to combine its structural features into Gray, but rather to use the teaching of Narayanaswamy to have a operating keys are operable under state that the display portion is closed. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Gray in view of Narayanaswamy.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in order to capable of presenting more useable information to the user as suggested by Narayanaswamy at column 1, lines 40-44.

Regarding the rejection of claims 1, 4, 6, 8-9, and 13. In response to applicant's remark on page 8, Applicant argues that Gray reference teaches away from the claimed invention.

In contrast to applicant's assertions, **teaching a different way is not considered as teaching away**. Furthermore, one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Gray disclose the portable wireless telephone having two elongate chassis sections which can be rotated around the axis for open and close through an arc to make a telephone to be compact and to be easily received within the pockets of the user's clothing, purses or handbags. Furthermore, Gay also disclose the display portion housing include the LCD 20 for display the information when the chassis section 12 in close position (figures 1-3, col.5-6, ln.50-67, 1-67), and there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Gray in view of Narayanaswamy. Therefore, the gray reference is not teaching away from claimed invention.

In response to applicant's remark, Applicant argues that the examiner has fails to combine Gray, Narayanaswamy, and Kfoury in claims 2-3, 5, 10-12, 14-16, 18, and 20-22.

In response to applicant's arguments as stated above, the Examiner respectfully disagrees with the Applicant's argument. It appears applicant is attacking individual merits of Gray, Narayanaswamy, and Kfoury, and concludes that there is no impetus to combine them. However, the 103 rejection is in consideration of Gray, Narayanaswamy, and Kfoury as a whole. One cannot show non-obviousness by attacking references individually. *In re Keller*, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of

references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Narayanaswamy and Kfoury as a secondary teaching is not to combine its structural features into Gray. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Gray, Narayanaswamy, and Kfoury.

Regarding the rejection of claims 2-3, 5, 10-12, 14-16, 18, and 20-22. In response to applicant's remark on page 10, Applicant argues that Gray reference teaches away from the claimed invention.

In contrast to applicant's assertions, **teaching a different way is not considered as teaching away**. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Gray disclose the portable wireless telephone having two elongate chassis sections which can be rotated around the axis for open and close through an arc to make a telephone to be compact and to be easily received within the pockets of the user's clothing, purses or handbags. Furthermore, Gay also disclose the display portion housing include the LCD 20 for display the information when the chassis section 12 in close position (figures 1-3, col.5-6, ln.50-67, 1-67), and there is an existing a strong prima facie case of obviousness

under 35 U.S.C 103, and proper to combine Gray, Narayanaswamy, and Kfoury.

Therefore, the gray reference is not teaching away from claimed invention.

In response to applicant's remark, Applicant argues that the examiner has fails to combine Gray, Narayanaswamy, Kfoury, and Lim in claim 17, and applicant also alleges that there is no motivation to combine Gray, Narayanaswamy, Kfoury, and Lim.

In response to applicant's arguments as stated above, the Examiner respectfully disagrees with the Applicant's argument. It appears applicant is attacking individual merits of Gray, Narayanaswamy, Kfoury, and Lim, and concludes that there is no impetus to combine them. However, the 103 rejection is in consideration of Gray, Narayanaswamy, Kfoury, and Lim as a whole. One cannot show non-obviousness by attacking references individually. In re Keller, 208 USPQ 871 (CCPA 1981). The test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art. In re Bozek, (CCPA) 163 USPQ 545. The question in a rejection for obviousness on a combination of references is what secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in basic reference structure. In re Richman, 165 USPQ 509 (CCPA 1970). In this regard, the intent of Narayanaswamy, Kfoury, and Lim as a secondary teaching is not to combine its structural features into Gray. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103, and proper to combine Gray, Narayanaswamy, and Kfoury. Furthermore, Lim does not teaches an inclined surface that is inclined at an angle of (180-

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predetermined angle)/2 as claimed. However, Lim does disclosed the inclined angle to keep the display and the keypad at a predetermined angle, by selecting the different angle as claimed would not involve any inventive feature since it just a design choice to have the inclined angle that keep the microphone and the speaker space apart for easy operating.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in order to calculate the predetermined angle of the housing of mobile phone when open or close as suggested by Lim at column 3, lines 28-31.

Base on the above rational, it is believed that the claimed limitations are met by the combination of Gray, Narayanaswamy, Kfoury, and Lim and therefore, the rejection are still maintained.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Pham whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 2, 2006
Examiner

Tuan Pham

Supervisory Patent Examiner
Technology Center 2600

Matthew Anderson